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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,059	09/19/2001	Itaru Hatanaka	1046.1261	8631

21171 7590 01/08/2008
STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

PIZIALI, JEFFREY J

ART UNIT	PAPER NUMBER
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2629

MAIL DATE	DELIVERY MODE
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01/08/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/955,059

Applicant(s)

HATANAKA ET AL.

Examiner

Jeff Piziali

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, 83, 109, 111-115, 121-123 and 128 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims:

Claims pending in the application are 19,21-25,29,31-33,38,61,64,66-70,74,76-78,83,109,111-115,121-123 and 128.

DETAILED ACTION

Election/Restrictions

1. Applicants' election without traverse of Species I (i.e., claims 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, 83, 109, 111-115, 121-123, and 128) in the reply filed on 8 March 2007 is acknowledged and appreciated.
2. All the remaining claims (e.g., claims 1-18, 20, 26-28, 30, 34-37, 39-60, 62, 63, 65, 71-73, 75, 79-82, 84-108, 110, 116-120, 124-127, and 129-135) drawn to nonelected species have been canceled by the '*Response to Notice of Non-Compliant Amendment*' (filed 24 October 2007).
3. Applicants are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Priority

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "6a" (e.g., see Figure 4) and "21a" (e.g., see Figure 23). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. The disclosure is objected to because of the following informalities: On Page 32, Line 5 of the specification; "*objet*" should be amended to "*object*." Appropriate correction is required.
7. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objections

8. Claim 19 is objected to because of the following informalities: the phrase "*where said processing unit*" (in line 7) appears misplaced. Appropriate correction is required.
9. Claim 61 is objected to because of the following informalities: the phrase "*a machine, tangible embodying*" (in lines 1-2) is grammatically improper. Appropriate correction is required.
10. Claim 64 is objected to because of the following informalities: the phrase "*a machine, tangible embodying*" (in lines 1-2) is grammatically improper. Appropriate correction is required.
11. Claim 66 is objected to because of the following informalities: the phrase "*a machine, tangible embodying*" (in line 1) is grammatically improper. Appropriate correction is required.
12. Claim 77 is objected to because of the following informalities: the phrase "*a machine, tangible embodying*" (in line 1) is grammatically improper. Appropriate correction is required.
13. Claim 83 is objected to because of the following informalities: the phrase "*a machine, tangible embodying*" (in line 1) is grammatically improper. Appropriate correction is required.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

15. Claims 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, 83, 109, 111-115, 121-123, and 128 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

16. Claim 19 recites the limitation "*the pointing manipulation*" in line 4. There is insufficient antecedent basis for this limitation in the claim. Although the claim recites "*a pointing unit*" and "*pointing a position*"; there is no basis for a "*pointing manipulation*." It would be unclear to one having ordinary skill in the art whether "*pointing a position*" and the "*pointing manipulation*" are one and the same; or rather whether they represent two distinct and independent operations of the instant invention.

17. Claim 19 recites the limitation "*the first data*" in line 9 and the limitation "*the second data*" in line 10. There is insufficient antecedent basis for either limitation in the claim.

18. Claim 19 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between the step of "*recording data*" (in line 14), "*the first data*"

(in line 9), and "*the second data*" (in line 10). It would be unclear to one having ordinary skill in the art whether the *first* and/or *second data* is/are the *recorded data*; or rather whether all sets of claimed *data* are distinct and independent of the remaining others.

19. Claim 21 recites the limitation "*the pointing manipulation*" in line 4. There is insufficient antecedent basis for this limitation in the claim.

20. Claim 29 recites the limitation "*the pointing manipulation*" in line 4. There is insufficient antecedent basis for this limitation in the claim.

21. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between "*a motion picture*" (in line 2), "*a reproducing unit*" (in line 10), and the step of "*reproducing the motion picture recorded on a recording medium*" (in lines 10-11). It would be unclear to one having ordinary skill in the art whether the reproducing unit is recording the motion picture to a recording medium; or rather whether the reproducing unit is reproducing a motion picture already earlier recorded on a recording medium. Additionally, it would be unclear to an artisan whether there is a single, common motion picture being claimed; or rather whether there are two distinct and independent motion pictures being claimed and manipulated.

22. Claim 29 recites the limitation "*a second image*" in line 12. There is insufficient antecedent basis for this limitation in the claim. In particular, no other *first image* has been recited. It would be unclear to one having ordinary skill in the art whether there is a single image being claimed; or rather whether there exist a plurality of images.

23. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between "*an object*" (in line 5) and "*an object*" (in line 13). It would be unclear to one having ordinary skill in the art whether there is a single object being claimed; or rather whether there exist a plurality of objects incorporated into the claimed invention.

24. Claim 32 recites the limitation "*the pointing manipulation*" in line 4, and the limitation "*the object*" in line 6. There is insufficient antecedent basis for either limitation in the claim.

25. Claim 38 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between "*a data distribution system*" (in line 1) and "*a data distribution system*" (in line 3). It would be unclear to one having ordinary skill in the art

whether there is a single data distribution system being claimed; or rather whether there exist a plurality of data distribution systems incorporated into the claimed invention.

26. Claim 38 recites the limitation "*the pointing manipulation*" in line 4, and the limitation "*the object*" in line 7. There is insufficient antecedent basis for either limitation in the claim.

27. Claim 61 recites the limitation "*the pointing manipulation*" in line 5, the limitation "*the first data*" in line 9, and the limitation "*the second data*" in line 10. There is insufficient antecedent basis for these limitations in the claim.

28. Claim 61 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between the step of "*recording the data*" (in line 13), "*the first data*" (in line 9), and "*the second data*" (in line 10). It would be unclear to one having ordinary skill in the art whether the *first* and/or *second data* is/are the *recorded data*; or rather whether all sets of claimed *data* are distinct and independent of the remaining others.

29. Claim 64 recites the limitation "*the pointing manipulation*" in line 5, the limitation "*the first data*" in line 9, and the limitation "*the second data*" in line 10. There is insufficient antecedent basis for these limitations in the claim.

30. Claim 64 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between the step of "*recording data*" (in line 15), "*the first data*" (in line 9), and "*the second data*" (in line 10). It would be unclear to one having ordinary skill in the art whether the *first* and/or *second data* is/are the *recorded data*; or rather whether all sets of claimed *data* are distinct and independent of the remaining others.

31. Claim 66 recites the limitation "*the pointing manipulation*" in line 4. There is insufficient antecedent basis for this limitation in the claim.

32. Claim 77 recites the limitation "*the pointing manipulation*" in line 6, and the limitation "*the object*" in line 8. There is insufficient antecedent basis for either limitation in the claim.

33. Claim 83 recites the limitation "*the pointing manipulation*" in line 7, and the limitation "*the object*" in line 9. There is insufficient antecedent basis for either limitation in the claim.

34. Claim 109 recites the limitation "*the pointing manipulation*" in line 4, the limitation "*the first data*" in line 8, and the limitation "*the second data*" in line 9. There is insufficient antecedent basis for these limitations in the claim.

35. Claim 109 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are between the step of "*recording data*" (in line 14), "*the first data*" (in line 8), and "*the second data*" (in line 9). It would be unclear to one having ordinary skill in the art whether the *first* and/or *second data* is/are the *recorded data*; or rather whether all sets of claimed *data* are distinct and independent of the remaining others.

36. Claim 109 recites the limitation "*said predetermined processing*" in line 11. There is insufficient antecedent basis for this limitation in the claim. Although the claim recites "*a predetermined process*" (in line 6); there is no basis for a "predetermined processing." It would be unclear to one having ordinary skill in the art whether "*said predetermined processing*" and the "*predetermined process*" are one and the same; or rather whether they represent two distinct and independent process/processing operations of the instant invention.

37. Claim 111 recites the limitation "*the pointing manipulation*" in line 4. There is insufficient antecedent basis for this limitation in the claim.

38. Claim 122 recites the limitation "*the pointing manipulation*" in line 5, and the limitation "*the object*" in line 7. There is insufficient antecedent basis for either limitation in the claim.

39. Claim 128 recites the limitation "*the pointing manipulation*" in line 6, and the limitation "*the object*" in line 8. There is insufficient antecedent basis for either limitation in the claim.

40. The remaining claims (e.g., claims 22-25, 31, 33, 67-70, 74, 76, 78, 112-115, 121, and 123) are rejected under 35 U.S.C. 112, second paragraph, at least as being dependent upon rejected base claims.

Claim Rejections - 35 USC § 101

41. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

42. Claims 61, 64, 66-70, 74, 76-78, 83, 109, 111-115, 121-123, and 128 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The instant specification discloses: "*The program executed by the computer to execute the processes in the image receiver 1, the pointing process server 11, the video deck 20, the video recorder 20a, the picture recording/reproducing device 60 the add-up server display device or server in the embodiments discussed above, may be recorded on a readable-by-computer recording medium. Then, the computer reads and executes the program on this recording medium, thereby providing one of the functions shown in the embodiments discussed above.*"

"Herein, the readable-by-computer recording medium which may be called as storage medium readable by a machine embraces recording mediums capable of storing information such as data, programs, etc. electrically, magnetically, optically and mechanically or by chemical action, which can be all read by the computer. What is demountable out of the computer among those recording mediums may be, e.g., a floppy disk, a magneto-optic disk, a CD-ROM, a CD-R/W, a DVD, a DAT, an 8 mm tape, a memory card, etc. . . .

"Further, a hard disk, a ROM (Read Only Memory) and so on are classified as fixed type recording mediums within the computer....

*"Furthermore, the above program may be stored in the hard disk and the memory of the computer, and downloaded to other computers via communication media. In this case, the program is transmitted as data communication signals embodied in **carrier waves** via the communication media. Then, the computer downloaded with this program can be made to provide one of the above functions.*

*"Herein, the communication media may be any one of cable communication mediums such as metallic cables including a coaxial cable and a twisted pair cable, optical communication cables, or **wireless communication media** such as **satellite communications**, **ground wave wireless communications**, etc.*

*"Further, the **carrier waves** are **electromagnetic waves** for modulating the data communication signals, or the **light**. The **carrier waves** may, however, be **DC signals**. In this case, the data communication signal takes a **base band waveform** with **no carrier wave**. Accordingly, the data communication signal embodied in the **carrier wave** may be anyone of a **modulated broadband signal** and an **unmodulated base band signal** (corresponding to a case of*

setting a DC signal having a voltage of 0 as a carrier wave)" (see Page 104, Line 10 - Page 105, Line 26).

As such, the claimed storage medium readable by a machine (of claims 61, 64, 66-70, 74, 76-78, 83), control method steps (of claims 109, 111-115, 121), and information processing method steps (of claims 122, 123, and 128) appear to be to abstract ideas rather than practical applications of ideas; they do not result in physical transformations, nor do they appear to provide useful, concrete and tangible results.

Response to Arguments

43. Applicant's arguments with respect to claims 19, 21-25, 29, 31-33, 38, 61, 64, 66-70, 74, 76-78, 83, 109, 111-115, 121-123, and 128 (see pages 12-15 of the '*Response to Notice of Non-Compliant Amendment*' filed 24 October 2007) have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Piziali whose telephone number is (571) 272-7678. The examiner can normally be reached on Monday - Friday (6:30AM - 3PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (571) 272-7681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeff Piziali
3 January 2008